

REMARKS

The Examiner rejected claims 63, 67, and 68 under 35 U.S.C. §112, first paragraph. Since claim 63 is cancelled, this portion of the rejection is avoided.

As to claim 67, the original translation of the PCT specification at page 19, lines 6-7 stated that both a continuous band and a cylinder can be used as the print carrier. Since the Examiner has required that this be shown in the drawings, a new Fig. 11 is enclosed. Also the Substitute Specification is amended at page 18 to describe new Fig. 11 with the continuous band 10' or the cylinder 10" as the print carrier 10. Also claim 67 was amended to recite a cylinder rather than a drum in accordance with the specification language.

The rejection of claim 68 is avoided since this claim is cancelled.

The Examiner rejected claims 39-41 and 47-49 under 35 U.S.C. §103 as unpatentable over Heinzl. Claims 50-52 were rejected under 35 U.S.C. §102 as anticipated by Heinzl. Claims 42-44 and 54-55 were rejected under 35 U.S.C. §103 as unpatentable over Heinzl in view of Uesugi. Claims 45-46, 56-61, 65-67, and 69-70 were rejected under 35 U.S.C. §103 as unpatentable over Heinzl in view of D'Heureuse. Claim 62 was rejected under 35 U.S.C. §103 as unpatentable over Heinzl in view of D'Heureuse and further in view of Kuroki. Claim 63 is rejected under 35 U.S.C. §103 as unpatentable over Heinzl, D'Heureuse, and Kuroki further in view of Mugrauer. Claim 64 is rejected under 35 U.S.C. §103 as unpatentable over Heinzl in view of D'Heureuse further in view of Kuroki further in view of Miyagawa.

Claim 39 distinguishes over Heinzl at least by reciting that a wetting-aiding substance is applied where the layer thickness smaller than .1 μm has a surfactant, this surfactant is structured, and then after the structuring process the surfactant is coated from a fountain solution to form the ink-attracting and ink-repelling regions. This clearly distinguishes over Heinzl where a thin ice is applied with a roller (column 4, line 26) and then water vapor is formed on the thin ice which is then cooled to ice. Thereafter the ice layer formed of the two layers is structured at 48. In claim 39, the thin (smaller than .1 μm) wetting-aiding substance is structured *before* application of the fountain solution layer. This has the advantage that less energy is necessary for structuring the wetting-aiding substance surfactant prior to application of the fountain solution layer. To the contrary in Heinzl, the structuring at 48 occurs to both the ice layer and the tenside layer. This requires more energy. Claim 39 readily distinguishes.

At page 13 of the Office Action, the Examiner stated: "Regarding the argument that the order of Heinzl is different than Applicants, the Examiner notes that the language used by Applicants in the claims merely requires that the claim steps be present." Applicants disagree for the following reasons.

In *Mantech Environmental Corporation v. Hudson Environmental Services, Inc.*, 152 F.2d 1368, 1376 (Fed. Cir. 1998), the Court stated"... that the sequential nature of the claims steps is apparent from the plain meaning of the claim language and nothing in the written description suggests otherwise". The same is clearly true here. The claims, even before the present Amendment, clearly indicate that the .1 μm thick surfactant layer is structured *before* application of the

fountain solution layer. This is clear from the order of the claim steps themselves and from the specification. However, to insure that there is no misunderstanding as to the importance of this order of steps, Applicants have amended the claim to specifically recite that the coating of the surfactant with the fountain solution layer is *after* the structuring process. Claim 39 thus readily distinguishes both before and after this Amendment. This Amendment is not considered a narrowing of claim 39 (or the other independent claims where similar amendments have been made) since claim 39 prior to this Amendment already made it clear that the order of the steps was important. Also, no new issue is raised by this Amendment because the previous claim steps clearly indicated that the coating of this surfactant with the fountain solution occurred *after* the structuring process because *it followed the structuring process* in the claim.

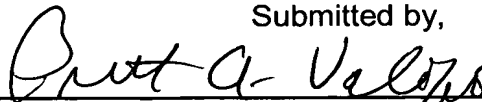
The Examiner also indicated at page 13 that the thickness of the tenside layer of Heinzl meets the .1 μm limitation of claim 39. Applicants disagree. The .1 μm limitation of Applicants claim 39 is nowhere present or suggested in Heinzl since no thickness is disclosed in Heinzl for the tenside. By providing the surfactant layer with a thickness of less than .1 μm allows for reduced energy to be used in the structuring.

None of the secondary references cited by the Examiner cure the defect of Heinzl. Accordingly, not only is claim 39 allowable, but all the claims in the case are allowable, since all the claims include the limitation of structuring the surfactant layer before application of the fountain solution layer. For example, even device claim 50 states that the fountain solution application station is *after*

the image generation station, so therefore the fountain solution layer is applied after structuring of the thin surfactant layer.

Allowance of the case is respectfully requested.

Submitted by,



(Reg. 28,982)

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CERTIFICATE OF MAILING

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IN THE DRAWINGS:

Please enter new drawing Figure 11 attached herewith. No new matter is entered.